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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,604	12/29/1999	GREG GRIFFITH	BELL-0017/99	1193

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EXAMINER

MILORD, MARCEAU

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/473,604

Applicant(s)

GRIFFITH ET AL.

Examiner

Marceau Milord

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thorne (US Patent No 6021310) in view of Lorello et al (US Patent No 6208870 B1).

Regarding claim 1, Thorne discloses a method of coupling a portable communications device (fig. 1) to a first network (fig. 4 where elements 54 and 56 are connected to an outside network; col. 5, line 60- col. 6, line 6) by way of a second network (fig. 4 where elements 48 and 34 are connected to PSTN which is a second network; col. 5, line 63- col. 6, line 35), the PCD (paging device 10 of fig. 1) normally in radio communication with the first network (fig. 4), the PCD (paging device 10 of fig. 1) being coupled to the first network by way of the second network ( col. 5, line 60- col. 6, line 65) ; establishing ( pager 10 in fig. 1 can establish contact with a base station by way of a network connector 48 such as PSTN, col. 5 , line 30- col. 6, line 35 ; an external computing network such as the Internet ; for example the computerized paging

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device is able to receive and send e-mail messages and convert a received audio signal into a data signal, col. 8, lines 1-31) a network connection with the first network; and entering (34 of fig. 4 where a telephone line connection jack 34 is connected to the modem 48 for connection of the computerized paging device 10 to an external telephone line for wired telephone communication) into communication with the first network (col. 5, line 40- col. 6, line 35; col. 7, lines 4- 64).

However, Thorne does not specifically disclose the step of establishing a network connection with a first network by way of a second network, and entering into communication with the first network by way of the second network.

On the other hand, Lorello et al, from the same field of endeavor, discloses a short message service network adapted to send and receive short messages to and from communication devices subscribing to the SMS network allowing more than one short message service center to service an individual subscriber. The SMS network comprises at least one home location register that sends an SMS notification, or an equivalent notification message, to one predetermined SMSC among a plurality of SMSCs once a subscriber become available to receive at least one pending message from at least one of the plurality of SMSCs (col. 6, lines 26-65). Furthermore, Lorello shows in figure 1A, a SMSC 120 that includes a controller 126 that controls the communication between the SMSC 120 and the rest of the network via the interfaces 121 and 122, the storage and retrieval of short message in memory 127, and receipt and delivery of short message to and from the rest of the network (col. 7, lines 5-48; col. 9, lines 1-65; col. 10, lines 8-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the technique of Lorello to the communication system of Thorne in

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order to provide coverage for a dual mode cellular handset especially when the handset is outside the range of an associated telephone base station.

Claim 2 contains similar limitations addressed in claim 1, and therefore, is rejected under a similar rationale.

Regarding claims 3, 14, and 11, Thorne as modified discloses a method wherein the pager is a two-way pager (figs. 1 and 4), and wherein entering into communication comprises entering into two-way communication with the first network by way of the second network (col. 5, line 40- col. 6, line 35; col. 7, lines 4- 64).

Regarding claims 4-10, 15-16, Thorne as applied to claim 1 above differs from claim 4 in that fails to disclose the steps of de-coupling the PCD from the second network upon ending communication therewith; and causing the PCD to leave the second network mode and enter the first network mode.

However, Lorello et al, discloses a short message service network adapted to send and receive short messages to and from communication devices subscribing to the SMS network allowing more than one short message service center to service an individual subscriber. The SMS network comprises at least one home location register that sends an SMS notification, or an equivalent notification message, to one predetermined SMSC among a plurality of SMSCs once a subscriber become available to receive at least one pending message from at least one of the plurality of SMSCs (col. 6, lines 26-65). Furthermore, Lorello shows in figure 1A, a SMSC 120 that includes a controller 126 that controls the communication between the SMSC 120 and the rest of the network via the interfaces 121 and 122, the storage and retrieval of short message in memory 127, and receipt and delivery of short message to and from the rest of the network (col.

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7, lines 5-48; col. 9, lines 1-65; col. 10, lines 8-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the technique of Lorello to the communication system of Thorne in order to provide coverage for a dual mode cellular handset especially when the handset is outside the range of an associated telephone base station.

Regarding claims 12-13, Thorne discloses a method of coupling a portable communications device (fig. 1) to a first network (fig. 4 where elements 54 and 56 are connected to an outside network; col. 5, line 60- col. 6, line 6) by way of a second network (fig. 4 where elements 48 and 34 are connected to PSTN which is a second network; col. 5, line 63- col. 6, line 35), the PCD (paging device 10 of fig. 1) normally in radio communication with the first network (fig. 4), the PCD (paging device 10 of fig. 1) having a serial port and being coupled to the first network by way of the second network ( col. 5, line 60- col. 6, line 65) ; coupling ( paging device 10 of fig. 1) the PCD to the second network; causing the PCD to leave a first network mode and enter a second network mode ( col. 5, line 60- col. 6, line 65 ; pager 10 in fig. 1 can establish contact with a base station by way of a network connector 48 such as PSTN, col. 5 , line 30- col. 6, line 35 ; an external computing network such as the Internet ; for example the computerized paging device is able to receive and send e-mail messages and convert a received audio signal into a data signal , col. 8, lines 1-31) a network connection with the first network ; and entering ( 34 of fig. 4 where a telephone line connection jack 34 is connected to the modem 48 for connection of the computerized paging device 10 to an external telephone line for wired telephone communication) into communication with the network ( col. 5, line 40- col. 6, line 35; col. 7, lines 4- 64).

However, Thorne does not specifically disclose the step of establishing a network connection with a first network by way of the second network; and entering into communication with the first network by way of the cradle and the second network.

On the other hand, Lorello et al, from the same field of endeavor, discloses a short message service network adapted to send and receive short messages to and from communication devices subscribing to the SMS network allowing more than one short message service center to service an individual subscriber. The SMS network comprises at least one home location register that sends an SMS notification, or an equivalent notification message, to one predetermined SMSC among a plurality of SMSCs once a subscriber become available to receive at least one pending message from at least one of the plurality of SMSCs (col. 6, lines 26-65). Furthermore, Lorello shows in figure 1A, a SMSC 120 that includes a controller 126 that controls the communication between the SMSC 120 and the rest of the network via the interfaces 121 and 122, the storage and retrieval of short message in memory 127, and receipt and delivery of short message to and from the rest of the network (col. 7, lines 5-48; col. 9, lines 1-65; col. 10, lines 8-58). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the technique of Lorello to the communication system of Thorne in order to provide coverage for a dual mode cellular handset especially when the handset is outside the range of an associated telephone base station.

#### Response to Arguments

3. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marceau Milord whose telephone number is 703-306-3023. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian C. Chin can be reached on 703-308-6739. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MARCEAU MILORD

Marceau Milord

Examiner

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March 22, 2004